

Application No. 09/772,229

Docket No. 2005-012R
PATENTREMARKS

Claims 2, 3, 5-11, 18-20, 25, 26, 28-34, 41-43, 45, 46, 48-54 and 61-66 are pending. Claims 2, 7, 9-10, 25, 30, 32-33, 45, 50, and 52-53 have been amended. No new matter has added.

1. Restriction

The Examiner has required restriction of the claims under 35 U.S.C. § 121 into one of the following groups:

Group I: Claims 2-3, 5-6, 8, 11, 64, 25-26, 28-29, 34, 65, 45-46, 48-49, 51, 54 and 66, which the Examiner states are drawn to retrieving a target chemical from a database structure;

Group II: Claims 7-10, 31-33 and 50-53, which the Examiner states are drawn to displaying a target chemical including the chemical structure; and

Group III: Claims 18-20, 41-43 and 61-63, which the Examiner states are drawn to electronically ordering a target chemical.

As an initial matter, the applicant notes that the Examiner has apparently included claims 8 and 51 in both Group I and Group II. Because these claims are dependent claims based on claims 2 and 45, respectively, the applicant assumes that the Examiner intended to include claims 8 and 51 only in Group I.

The applicant also notes that the Examiner has not included claim 30 in any of the identified groups. Claim 30 is an independent claim directed to a system for determining parameters for chemical synthesis that comprises various means for performing functions analogous to the method steps set out in independent method claim 7. Accordingly, and because claims 32 and 33 are dependent claims based on claim 30, the applicant assumes that the Examiner intended to include claim 30 in Group II.

Finally, the applicant also notes that the Examiner has apparently included claim 31 in Group II. Claim 31 is a dependent claim based on independent claim 25. Accordingly, and because claim 31 recites a system that comprises various means for performing functions that are directly analogous to the method steps recited in claim 8, which is in Group I as noted above, the applicant assumes that the Examiner also intended to include claim 31 in Group I.

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Turning to the substance of the requirement, the applicant provisionally elects the invention of Group I, claims 2-3, 5-6, 8, 11, 64, 25-26, 28-29, 31, 34, 65, 45-46, 48-49, 51, 54 and 66. The election is made with traverse as to the requirement to elect between Group I and Group III.

While the applicant does not dispute the Examiner's conclusion that the identified groups are patentably distinct, MPEP §803 provides that if the search and examination of an entire application can be made without serious burden, the application must be examined on the merits, even though it includes claims to independent or distinct inventions. Here, the applicant submits that there is substantial overlap between the elected claims of Group I and the claims of Group III.

The applicant respectfully points out that the claims of Group I are not drawn to "retriev[ing] the target chemical from the database structure" as the Examiner has stated. Rather, taking claim 2 as an example, these claims generally recite techniques for determining parameters for chemical synthesis, including the steps of (1) accepting a user identification of a target chemical; (2) displaying a listing of reagent chemicals that can be used to synthesize the target chemical; (3) accepting a user selection from the listing of reagent chemicals; and (4) generating an electronic order for the target chemical and/or the reagent chemicals in response to the user selection. The claims of Group III, in turn, are generally directed to techniques for obtaining materials for chemical synthesis that involve (per claim 18) the generation, in response to user input, of an electronic order for a target chemical and/or reagent chemicals that are used to synthesize the target chemical based on a displayed listing of reagent chemicals and a procedure that can be used to synthesize the target chemical.

Thus, both sets of claims generally involve the display of a listing of reagent chemicals that can be used to synthesize a target chemical, and the generation of an electronic order for the target chemical and/or reagent chemicals based on the displayed listing. Because of this substantial overlap in the requirements of the claims, the applicant submits that the search for the Group I claims will necessarily include and overlap with the search for the Group III claims. The applicant therefore submits that all of these claims could be searched without an undue burden on the Examiner, and asks that the restriction be withdrawn.

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PATENT**2. Amendments**

Claims 1, 25 and 45 are amended to clarify the antecedent basis for the user selection in response to which the electronic order is generated. Claims 7 and 9-10, claims 30 and 32-33 and claims 50 and 52-53 have been amended in response to the restriction requirement to depend from elected claims 2, 25 and 45, respectively. The applicant reserves the right to pursue the subject matter of independent claims 7, 9-10, 30, 32-33, 50 and 52-53 in one or more divisional applications.

3. Conclusion

The applicant submits that all claims are now in condition for allowance. Please charge the fee of \$60.00 for a one month extension to Deposit Account 50-0496. Should any other charges be due, the Commissioner is authorized to charge the above-referenced deposit account.

Respectfully submitted,

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